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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/827,519	04/20/2004	Kazuhiro Kato	042338	2758

38834 7590 02/22/2006

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EXAMINER

BROWN, JENNINE M

ART UNIT PAPER NUMBER

1755

DATE MAILED: 02/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/827,519

Applicant(s)

KATO ET AL.

Examiner

Jennine M. Brown

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☒ Claim(s) 13-14 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/12/04

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 8/12/2004 was considered by the examiner.

Priority

Applicant cannot rely upon the foreign priority papers to overcome any intervening rejection because a certified English language translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Claim Objections

Claims 13 and 14 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim may refer in the alternative to only one set of claims. A claim such as "A device as in claims 1, 2, 3, or 4, made by a process of claims 5, 6, 7, or 8" is improper. 35 U.S.C. 112 allows reference to only a particular claim. Furthermore, a multiple dependent claim may not serve as a basis for any other multiple dependent claim, either directly or indirectly. These limitations help to avoid undue confusion in determining how many prior claims are actually referred to in a multiple dependent claim. See MPEP § 608.01(n). Accordingly, claims 13 and 14 have not been further treated on the merits.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10 uses claim language which is indefinite because the term "organic component" in this claim is unclear as to whether it is the derived organic component of claim 8 or the additional organic component of claim 9 which is not a derived organic component. Furthermore the organic component in claim 8 is derived from either the colloid or the core but cannot be devoid of both because it is present in the preceding claim.

Claim 11 recites the limitation "said organic component" with regard to "any of claims 6-10". There is insufficient antecedent basis for this limitation in claim 6.

Claims Analysis

Examiner defines colloidal or discrete particles as having less than 1 micron in diameter.

Claims 12-14 are product by process claims. According to MPEP 2113, "[e]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted).

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The examiner is interpreting claims 1-21 as product by process claims and as such the patentability depends upon the product itself and not necessarily the process by which the product is produced, unless applicant comes forward with evidence establishing an unobvious difference between the claimed product and the prior art product. Therefore novelty will primarily be determined by the metal colloid luster color material, the coating composition and the coating film as claimed.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Ito, et al. (US 4976787 A).

See entire document. Ito, et al. disclose a metal colloid luster color material comprising a core material ("substrate" - col. 2, l. 67-col. 3, l. 5) which includes glass flakes. The metallic layer can be formed on only a part of the surface of the substrate (col. 3, l. 7-9) in the form of metal dots (col. 3, l. 29-34; Figures 6 and 7) and comprises silver, gold or copper metal (col. 3, l. 14).

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Ito, et al. disclose a method of causing a metal colloid particle in solution to undergo adhesion to a surface of a core material (col. 7, l. 48-col. 8, l. 6) and the product produced therefrom was disclosed (col. 8, l. 20-33).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 5, 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ito, et al. (US 4976787 A) in view of Phillips, et al. (US 6676741 B2).

Ito, et al. disclose a metal colloid luster color material and method of producing a metal colloid luster color material as stated above. Ito, et al. do not expressly state that an organic compound is present in said metal colloid luster color material nor does the reference expressly state its use in a method of adhesion, derived from the metal colloid material or the core material or poor solvent.

Phillips, et al. discloses in the background of the invention that chemical methods of deposition and electroless plating methods are typically limited to materials that involve hydrocarbons (organic solvents) for metals such as silver that can be readily deposited by electroless processes (col. 2, l. 48-52). It would have been obvious to one of ordinary skill in the art that the electroless deposition processes in Ito, et al. would necessarily have used an organic solvent in the deposition process as disclosed by Phillips, et al., therefore it would have been obvious to one of ordinary skill in the art that an organic solvent would necessarily have been used in contacting the core material with the metal to be deposited thereupon.

Relevant Prior Art

Other references not specifically cited herein but cited on PTO-892 are considered germane to the patentability of applicant's invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennine M. Brown whose telephone number is (571) 272-1364. The examiner can normally be reached on M-R 9:30 AM - 7:30 PM; Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jmb


J. A. LORENZO
SUPERVISORY PATENT EXAMINER